

FORM PTO-1390

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NUMBER
CACO-0067TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371U.S. APPLICATION NO. (if known see 37 C.F.R. 1.5)
09/889,765INTERNATIONAL APPLICATION NO.
PCT/GB00/00157INTERNATIONAL FILING DATE
21 January 2000PRIORITY DATE CLAIMED
22 January 1999

TITLE OF INVENTION SELECTION PROCEDURE USING PRODRUG/ENZYME SYSTEM # 3

APPLICANT(S) FOR DO/EO/US SEARLE, PETER F.

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This express request to begin national examination procedures (35 U.S.C. 371(f)) at any time rather than delay examination until the expiration of the applicable time limit set in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☐ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☐ A copy of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☐ is transmitted herewith (required only if not transmitted by the International Bureau).
 - b. ☐ has been transmitted by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US)
6. ☐ A translation of the International Application into English (35 U.S.C. 371(c)(2)).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
 - a. ☐ are transmitted herewith (required only if not transmitted by the International Bureau).
 - b. ☐ have been transmitted by the International Bureau.
 - c. ☒ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☐ have not been made and will not be made.
8. ☐ A translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An oath or declaration of the inventor(s) 35 U.S.C. 371(c)(4).
10. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11. to 16. below concern other document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☒ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A FIRST preliminary amendment.
14. ☒ A SECOND or SUBSEQUENT preliminary amendment.
14. ☐ A substitute specification.
15. ☐ A change of power of attorney and/or address letter.
16. ☒ Other items or information:
 - Communication
 - Copy of Notification of Missing Requirements dated October 12, 2001.
 - Associate Power of Attorney.

11/28/2001 UEDUVIJE 00000046 09889761

01 FC:254

65.00 OP

EXPRESS MAIL Mailing Label No. EL 899364629 US

Date of Deposit: 06 November 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

MAILER John Hill

SIGNATURE

EL899364629US

U.S. APPLICATION NO. (if known 37 C.F.R. 1.5)
09/889,761

INTERNATIONAL APPLICATION NO.
PCT/GB00/00157

ATTORNEY DOCKET NUMBER
CACO-0067

17. The following fees are submitted.

Basic National Fee (37 CFR 1.492(a)(1) - (5)):

Neither international preliminary examination fee (37 CFR 1.482)
nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO
and International Search Report not prepared by the EPO or JPO.....\$1,040.00

International preliminary examination fee (37 CFR 1.482 not paid to USPTO
but International Search Report has been prepared by the EPO or JPO.....\$890.00

International preliminary examination fee (37 CFR 1.482) not paid to USPTO but
international search fee (37 CFR 1.445(a)(2)) paid to USPTO.....\$740.00

International preliminary examination fee paid to USPTO (37 CFR 1.482) but
all claims did not satisfy provisions of PCT Article 33(1)-(4).....\$710.00

International preliminary examination fee paid to USPTO (37 CFR 1.482) and
all claims satisfied provisions of PCT Article 33(1)-(4).....\$100.00

ENTER APPROPRIATE BASIC FEE AMOUNT =

\$

Surcharge of \$130.00 for furnishing the oath or declaration later than 20 X 30 months from
the earliest claimed priority date (37 CFR 1.492(e)).

\$ 65.00

| Claims | Number Filed | Number Extra | Rate | | |
|---|--------------|--------------|------------|---------------------------|----------|
| Total claims | - 20 = | | X \$18.00 | \$ | |
| Independent Claims | - 3 = | | x \$84.00 | \$ | |
| Multiple dependent claims(s) (if applicable) | | | + \$280.00 | \$ | |
| TOTAL OF ABOVE CALCULATIONS = | | | | \$ 65.00 | |
| <u> </u> Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2. | | | | \$ | |
| SUBTOTAL = | | | | \$ 65.00 | |
| Processing fee of \$130.00 for furnishing the English translation later than <u> </u> 20 <u> </u> 30 months from the earliest claimed priority date (37 CFR 1.492(f)). | | | | + | \$ |
| TOTAL NATIONAL FEE = | | | | \$ 65.00 | |
| Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property | | | | + | \$ 40.00 |
| TOTAL FEES ENCLOSED = | | | | \$105.00 | |
| | | | | Amount to be: refunded | \$ |
| | | | | charged | \$ |

a. X A check in the amount of \$ 105.00 to cover the above fee is enclosed.

b. Please charge my Deposit Account No. 23-3050 in the amount of \$ to cover the above fees. A duplicate copy of this sheet is enclosed.

c. X The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 23-3050. A duplicate copy of this sheet is enclosed.

NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

Doreen Yatko Trujillo
Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103
(215) 568-3100


SIGNATURE

Robin S. Quartin
NAME

45,028
REGISTRATION NUMBER

DOCKET NO: CACO-0067

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: SEARLE, Peter F.

U.S. Serial No.: 09/889,761

Group Art Unit: not yet known

International Application No.: PCT/GB00/00157

Examiner: not yet assigned

International Filing Date: 21 January 2000

For: SELECTION PROCEDURE USING PRODRUG/ENZYME SYSTEM

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:


COMMUNICATION

In response to the Notification of Missing Requirements dated October 12, 2001, Applicant submits herewith the executed Declaration/Power of Attorney along with the surcharge of \$65.00 under 37 CFR 1.492 (e).

It is our understanding that, upon further review of the application, there are **35** claims. There are **15** total claims over 20, not 16 as indicated on the Notification of Missing Requirements. Therefore, an additional claims fee is not required. If it is determined that this is not correct, the Commissioner is hereby authorized to charge any additional claims fee to Deposit Account No. 23-3050.

Respectfully submitted,

Date: November 6, 2001


Robin S. Quartin
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